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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/239,873	01/29/1999	CINDIE M. LUHMAN	LL11.12-0040	6642

164 7590 02/20/2003

KINNEY & LANGE, P.A.
THE KINNEY & LANGE BUILDING
312 SOUTH THIRD STREET
MINNEAPOLIS, MN 55415-1002

EXAMINER

LEVY, NEIL S

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 02/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art. Unit

09 239823

LUTTMAN

JEN Lory

1616

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—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 1/3/03
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-4, 8-11, 13/4, & 28-82 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 25-82 is/are allowed.
- ☒ Claim(s) 1-3, 8-10, 13, 14, 28-39, 32, 34-37, 44-59 is/are rejected.
- ☒ Claim(s) 41, 42, 43, 44, 45, 46, 47, 48, 49, 50, 51, 52, 53, 54, 55, 56, 57, 58, 59, 60, 61, 62, 63, 64, 65, 66, 67, 68, 69, 70, 71, 72, 73, 74, 75, 76, 77, 78, 79, 80, 81, 82, 83, 84, 85, 86, 87, 88, 89, 90, 91, 92, 93, 94, 95, 96, 97, 98, 99, 100 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 25
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Receipt is acknowledged of RCE, amendment, Declaration and IDS of 1/3/03 each examiner appreciates cancellation of traversed claims in order to advance prosecution.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 09/338314. Although the conflicting claims are not identical, they are not patentably distinct from each other because the rejection of record is maintained, as examiner discerns no change in either set of claims to date.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 8-10, 29-32, 34-37, 44-53, 56, 59 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the

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specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The rejection of record is maintained, to the extent that the claims, broadly interpreted, are beyond the scope of the specification – applicant's remarks include pointing to administration of 50 + g/day of sugar alcohol, of which at least 50% must be available to the abomasums. This supports the basis for an enhanced milk component effect, in the absence of defining what is meant by "enhanced".

The issue examiner raised as requiring some statistical significance guideline, in order for one to know when an effect has resulted as opposed to a chance enhancement. Applicant ^{argues this is} a non-issue ~~argued by the examiner~~, but absent some guideline, not evident to examiner in the specification, the prior art has already shown enhanced milk component effects of administering sugar alcohols. It can be further argued, that "enhance" does not require an increase, statistically significant or not, in a milk component, but only provides an ancillary, or adjuvant, or synergistic effect, which may not be identifiable or measurable as a direct effect on a milk component. The specification, as far as examiner can discern, does not require any particular level of increase in a milk component directly tied to any sugar alcohol (except sorbitol), and does not preclude the stated speculative interpretation of enhancing a milk component. As to the balance of applicants' arguments against the 112 rejection, applicant has provided clarification and pointed to support, negating the concerns expressed by examiner.

Claims 1-~~8~~, 9-1~~0~~, 13, ~~28~~, ~~33~~, ~~38-43~~, 54-59 are rejected under 35 U.S.C. 102(b) as being anticipated by Merensalmi - 4127676.

The rejection of record is maintained, because, absent any qualifications, Merensalmi must have provided sugar alcohol to the abomasums by feeding, as enhanced milk component production resulted. In fact, Merensalmi states it was known to feed propylene glycol, glycerol, which are known to not breakdown, but pass intact, through the rumen, and effect an enhancement in milk component production (col. 1, last paragraph). Note the instant Language is open, thus new claims are also met.

Claims 1, 8-10, 13, 14, 29-32, 34-37, 54-59 are rejected under 35 U.S.C. 102(b) as being anticipated by Khalili et al '97.

The rejection of record is maintained.

Note an enhancement (increase in Milk yield) was seen (abstract) when glycerol was fed with free fatty acids.

Claims 1, 9, 10, 13, 54, 55, 57, 58 are rejected under 35 U.S.C. 102(b) as being anticipated by Makinen et al - '81.

The rejection of record is maintained.

Again, milk component enhancement resulted, so the alcohols reached abomasums.

Applicant's arguments filed s 1/3/03 have been fully considered but they are not persuasive. Applicants arguments have been considered, as have the declaration by forter, attached exhibits, and attached IDS of non-lactating references. As to the latter, examiner had been unable to introduce in particular the G Bond Hornykiewytsch

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patents, as there is no evident anticipation or motivation to direct one to administer sugar alcohols with a basis for expectation of direct enhancement of milk component production. As to Porter, in essence, examiner finds this an interpretation rather than any data presentation, with rationalization presented for non-enablement of U.S. Patent. Examiner fails to see the relevance to the invention as it is claimed. Likewise, the traversals of the references are seen as not noteworthy, in view of the instant claim Language. However we find Redmond to not anticipate, and insubstantial combination with prior art.

Smith provides sugar alcohols, they're components of, the mix Smith feeds – distillers grains – Col. 2, line 33, or brewers grains, or malt sprouts (col. 5, line 5) but at best is cumulative.

In essence, examiner finds the traversals based upon ^{denial} ~~detail~~ of the attainment of the abomasums by the sugar alcohols fed. However, there is no basis for this, as the references feed sugar alcohols and get enhancement in some form or other, of a milk component; so a sufficient amount must have gotten to the abomasums to provide these effects in accord with applicant's claims; not applicant's invention.

Claims 4, ~~33, 38-43, 55, 57, 58~~, 60-74 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil Levy whose telephone number is (703) 308-2412. The examiner can normally be reached on Tuesday through Friday 7 AM to 5:30 Pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on (703) 308-4628. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Levy/LR
February 12, 2003



NEIL S. LEVY
PRIMARY EXAMINER